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Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830

EXAMINER

RICHARDSON, THOMAS W

ART UNIT	PAPER NUMBER
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/761,059	Applicant(s) PASTRO ET AL.	
	Examiner THOMAS RICHARDSON	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-46 are pending for examination.

Claims 1-46 are rejected.

Response to Arguments

1. Applicant's arguments filed 02 January 2009 have been fully considered but they are not persuasive. Applicant argues that cited references Wengrovitz (US 2004/0205209) and Sherman (US 7 020 460) fail to teach all of the limitations present in the independent claims. Examiner disagrees.

2. Applicant argues that Sherman does not teach full IM capability provided to a telephone set. Applicant argues further than Sherman's buddy list is not equivalent to an IM buddy list of keeping mobile users aware of other users' availability. Sherman teaches a buddy list in conjunction with a notification service that updates a list of active and enabled buddies for a user (column 9, lines 54-57). In addition, the mobile customer may utilize instant messaging on the telephone (column 10, lines 17-25). Sherman thus teaches the use of mobile IM with the use of a buddy list. As such, the rejection of independent claims 1, 14, 32, and 42, along with the subsequent dependent claims, is maintained.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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4. Claims 1-10, 14-17, 19-27, and 32-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0205209, Wengrovitz et al and US 7 020 460, Sherman et al.

5. As per claim 1, Wengrovitz teaches an apparatus for performing instant messaging (IM) under a first protocol, said apparatus comprising:

a first device (Figure 1, 16, SIP set utilizing SIP protocol);

a second device implementing a second protocol, (Figure 1, 12, digital set utilizing PDSV protocol);

a protocol converter to convert between said first protocol and said second protocol (Figure 1, 26, protocol converter);

a register to register said first device and said second device (Figure 1, 18, also Figure 5B, also paragraph 67, SIP-PBX proxy server registers first and second device); and

a map to map a first client to said first device and a second client to said second device (Figure 3, 40, port mapping table maps the first and second client to the devices).

Wengrovitz does not expressly teach that the device may be a telephone set that employs IM capabilities. Sherman teaches a method for providing a network notification service wherein:

at least one of said first device and said second device is a telephone set with a keypad having a fixed number of key buttons and a display (Figure 2, subscribers); and

wherein full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 10, lines 20-21, where the mobile telephones

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may be used for instant messaging, also column 8, lines 24-35, where a user may be added to a user's buddy list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Sherman's teachings of usage of the telephone and IM capability with the teachings of Wengrovitz. Wengrovitz allows to convert messages that adhere to private, vendor-specific protocols to adhere to the SIP protocol (abstract). This would be beneficial with Sherman's teachings, as it would allow communications devices such as telephones to communicate by sending and receiving instant messaging messages.

6. As per claim 2, Wengrovitz further teaches the first protocol is SIP (Figure 1, 16, SIP set utilizing SIP protocol).

7. As per claim 3, Wengrovitz further teaches the second protocol is CSTA (Figure 29, also paragraph 113, CSTA is supported).

8. As per claim 4, Wengrovitz further teaches the first device is a SIP device (Figure 1, 16, SIP set utilizing SIP protocol).

Wengrovitz does not expressly teach managing presence information. Sherman further teaches:

managing and determining presence information for IM users (column 10, lines 17-20, where the availability of users may be seen from mobile telephones).

9. As per claim 5, Wengrovitz further teaches the first device is a PC (Figure 29, also paragraph 113, where the integration of CTI necessitates the use of a PC).

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10. As per claim 6, Wengrovitz further teaches the first device is a PDA (Figure 29, also paragraph 113, where the integration of CTI necessitates the use of a PC, a PDA is a type of mobile PC).

11. As per claim 7, Wengrovitz further teaches the second device is a telephone set, and the telephone set is a digital telephone (Figure 1, 12).

Wengrovitz does not expressly teach IM being displayed. Sherman teaches utilizing a telephone to compose and display instant messages using its key buttons and display (column 10, lines 17-25, where IM may be used on mobile telephones).

12. As per claim 8, Wengrovitz further teaches the digital telephone is connected through a telephonic switch (Figure 1, 10, also Figure 29, IP-PBX).

13. As per claim 9, Wengrovitz further teaches the telephonic switch is a PBX (Figure 1, 10, also Figure 29, IP-PBX).

Wengrovitz does not expressly teach IM capability on the telephone. Sherman teaches utilizing a telephone to compose and display instant messages (column 10, lines 17-25, where IM may be used on mobile telephones).

14. As per claim 10, Wengrovitz further teaches the first device is a second protocol device (Figure 1, 12, Digital set utilizing PDSV protocol).

15. As per claim 14, Wengrovitz teaches a method, comprising the steps of:
registering a first protocol digital telephone set (Figure 1, 18, also Figure 5B, also paragraph 67, SIP-PBX proxy server registers the first and second device);
converting said first protocol to a second protocol (Figure 1, 26, Protocol Converter);

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Mapping a client to said digital telephone set (Figure 3, 40, port mapping table maps the first client to the first device and the second client to the second device); and communicating an instant message to or from said digital telephone set (Figure 12, 144, also paragraph 85, where an instant message is transmitted with each key press). Wengrovitz does not expressly teach that the device may be a telephone set that employs IM capabilities. Sherman teaches a method for providing a network notification service wherein:

at least one of said first device and said second device is a telephone set with a keypad having a fixed number of key buttons and a display (Figure 2, subscribers); and

wherein full IM capability is provided to said telephone set, full IM capability including creating a buddy list (column 10, lines 20-21, where the mobile telephones may be used for instant messaging, also column 8, lines 24-35, where a user may be added to a user's buddy list).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Sherman's teachings of usage of the telephone and IM capability with the teachings of Wengrovitz. Wengrovitz allows to convert messages that adhere to private, vendor-specific protocols to adhere to the SIP protocol (abstract). This would be beneficial with Sherman's teachings, as it would allow communications devices such as telephones to communicate by sending and receiving instant messaging messages.

16. As per claim 15, Wengrovitz further teaches registering a second device (Figure 1, 18, also Figure 5B, also paragraph 67, SIP-PBX proxy server registers the first and second device); and

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wherein said mapping step further maps a second client to said second device (Figure 3, 40, port mapping table maps the first client to the first device and the second client to the second device) and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (Figure 12, 144, also paragraph 85, where an instant message is transmitted with each key press).

17. As per claim 16, Wengrovitz further teaches said second device is a PC (Figure 29, also paragraph 113, where the integration of CTI necessitates the use of a PC), and wherein said mapping step further maps a second client to said PC (Figure 3, 40, port mapping table maps the first client to the first device and the second client to the second device), and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (Figure 12, 144, also paragraph 85, where an instant message is transmitted with each key press).

18. As per claim 17, Wengrovitz further teaches said second device is a CSTA digital telephone set (Figure 1, 12, digital set utilizing PDSV protocol), and wherein said converting step also convert messages from said CSTA device to messages for a SIP device (Figure 1, 26, protocol converter), and wherein said mapping step further maps a second client to said PC (Figure 3, 40, port mapping table maps the first client to the first device and the second client to the second device), and said instant messaging includes communicating an instant message between said first digital telephone set and said second device (Figure 12, 144, also paragraph 85, where an instant message is transmitted with each key press).

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19. As per claim 20, Wengrovitz does not expressly teach notification of incoming IM messages. Sherman teaches a method for providing a network notification service comprising:

 sending a notification to said digital telephone set when a new instant message arrives, said digital telephone set displaying a new instant message notification in response (column 10, lines 17-25, where IM may be used on mobile telephones. It is well known in the art that when a telephone receives an IM, the telephone notifies the user and displays the message).

20. As per claim 21, Wengrovitz further teaches instant messaging is accomplished while the digital telephone set is off-hook (Figure 12, 135, also paragraph 85, where the user is off-hook and an instant message is transmitted without a dialed number with pressing the key).

21. As per claim 22, Wengrovitz does not expressly teach composing and displaying IMs utilizing the standard key buttons. Sherman teaches a method for providing a network notification service wherein:

 instant messaging includes composing and displaying instant messages using the standard key buttons and display space of the digital telephone set (Figures 2 and 3, where the telephone is a standard telephone with standard keys and displays, also column 10, lines 17-25, where IM may be used on mobile telephones).

22. As per claim 23, Wengrovitz does not expressly teach adding client to a contact list. Sherman teaches a method for providing a network notification service wherein:

instant messaging includes sending a notification to said digital telephone set when a request to add said digital telephone set client to the contact list of another instant messaging client is received (Figure 5, step 504, also column 8, lines 5-30, where the user must provide permission to be added to other contact lists, and others may add after permission is granted).

23. As per claim 24, Wengrovitz further teaches instant messaging includes using said digital telephone set to sign-in and sign-out for instant messaging services (Figure 12, 135, also paragraph 85, where the user is off-hook and an instant message is transmitted without a dialed number with pressing the key).

24. As per claim 25, Wengrovitz does not expressly teach changing the status of a device. Sherman teaches a method for providing a network notification service wherein:

instant messaging includes using said digital telephone set to change the on-line and off-line status of said digital telephone set (Figure 3, where status information is displayed for other users, also column 6, lines 23-59, where the device may be turned on or off to change availability status).

25. As per claim 26, Wengrovitz does not expressly teach maintaining the status of users. Sherman teaches a method for providing a network notification service wherein:

communicating includes using said digital telephone set to query the status of a contact list member (Figure 3, where status information is displayed for other users).

26. As per claim 27, Wengrovitz does not expressly teach maintaining the status of users. Sherman teaches a method for providing a network notification service wherein:

communicating includes determining the presence status of said digital telephone based on call activity of said digital telephone (Figure 3, where status information is displayed for other users).

27. Claims 32-40 and 42-45 list all the same elements of claims 1-5, 7-10, and 14-17, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 1-5, 7-10, and 14-17 applies equally as well to claims 32-40 and 42-45.

28. Claims 11-13, 18-19, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2004/0205209, Wengrovitz et al and US 7 020 460, Sherman et al as applied to claims 10 and 14 above, and further in view of US 2005/0013421, Chavez et al.

29. As per claim 11, Wengrovitz further teaches said first device is said telephone set and said telephone set is a digital telephone (Fig. 1, 12, also Fig. 29 Digital set).

However Wengrovitz does not explicitly teach: wherein at least one key button is a programmable key. In the same field of endeavor, Chavez teaches, (Fig. 7, also paragraph 21, reprogramming or redefining feature activator or the function keys on the phone indicates at least a programmable key button).

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message plus full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic

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messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

30. As per claim 12, Wengrovitz further teaches the digital telephone is connected through a telephonic switch monitoring said key buttons and having full control of said display (Figure 1, 10, also Figure 29, IP-PBX).

Wengrovitz does not expressly teach IM being displayed. Sherman teaches utilizing a telephone to compose and display instant messages using its key buttons and display (column 10, lines 17-25, where IM may be used on mobile telephones).

31. As per claim 13, Wengrovitz further teaches the telephonic switch is a PBX (Figure 1, 10, also Figure 29, IP-PBX).

32. As per claim 18, Wengrovitz further discloses, the step of configuring said at least one key button as an Instant Messaging (IM) key for a digital telephone set (Fig. 12, 144, also 85 an Instant message is transmitted with each key press). However Wengrovitz does not explicitly teach: at least one key button is a programmable key. In the same field of endeavor, Chavez teaches, (Fig. 7, paragraph 21) reprogramming or redefining feature activator or the function keys on the phone indicates at least a programmable key button.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched

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communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

33. As per claim 19, Wengrovitz further teaches establishing the IM connection by pressing said instant messaging key (Figure 12, 135, also paragraph 85, where an instant message is transmitted without a dialed number by pressing the key).

34. As per claim 28, Wengrovitz does not explicitly teach: instant messaging includes sending stored common replies to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraph 86) the message is saved and then sent as a response.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

35. As per claim 29, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 62 In the same field of

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endeavor, Chavez teaches, (paragraph 86) the stored text message is a text response created by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

36. As per claim 30, Wengrovitz does not explicitly teach: instant messaging includes sending stored common messages to other instant messaging clients. In the same field of endeavor, Chavez teaches, (paragraphs 87-88) the stored text message is transmitted in response to the sender.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

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37. As per claim 31, Wengrovitz does not explicitly teach: at least one of said stored common replies includes at least one custom data field. 68. In the same field .of endeavor, Chavez teaches, (paragraph 22) stored text messages are associated or mapped to keys, these messages can be customized by the user.

It would have been obvious to one of ordinary skill in the networking art at the time the applicant's invention was made to combine Chavez's teachings of usage of the keys and the display of the phone to compose the instant message and full IM capability with the teachings of Wengrovitz, for the purpose of enabling a circuit switched communication device such as a telephone, to receive and respond to electronic messages (see Chavez, abstract, lines 2-4). Wengrovitz provides motivation to do so, by converting messages that adhere to a private, vendor-specific protocol, to messages that adhere to the SIP protocol (see Wengrovitz, abstract, lines 10-12).

38. Claims 41 and 44 list all the same elements of claims 11 and 18, but in method form rather than system form. Therefore, the supporting rationale of the rejection to claims 11 and 18 applies equally as well to claims 41 and 44.

Conclusion

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS RICHARDSON whose telephone number is (571) 270-1191. The examiner can normally be reached on Monday through Thursday, 8am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2444